No. 3715

IN THE

United States

Circuit Court of Appeals,

FOR THE NINTH CIRCUIT.

Pacific States Electric Company,
Appellant,

vs.

William D. Wright,
Appellee.

SUPPLEMENTAL BRIEF FOR APPELLEE.

FREDERICK S. LYON,
LEONARD S. LYON,
Solicitors and Counsel for Appellee.

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We desire to briefly reply to certain contentions made in the reply brief for appellant and have obtained the permission of this Court to that effect. It is felt that there has been an attempt in appellant's reply brief to bemuddle the facts of this cause and confuse by reference to unsound and erroneous propositions of law.

Aaron Burr is reputed to have defined "law" as "whatever is boldly asserted and plausibly maintained." However incorrect this definition may be, it fits the instant case if appellant's position be deemed to even bear color of law.

We regret the undignified and unjustified manner employed by opposing counsel in referring to "Untrue, Erroneous and Misleading Portions of Appellee's Brief." Apparently counsel do not agree with the propositions advanced in appellee's brief, but nothing appears warranting descending to discourtesy. We have carefully reviewed each of the items referred to under the aforesaid heading and find no item that we do not consider correct and do not reaffirm. It has been said that to a great extent men live and die by and for catch words, and when argument fails resort may be had to charges. Calling your enemy names is one of the most common ways to do him injury. With such devices, useful as they may be to anyone seeking to influence the actions of people through their emotions, courts should have nothing to do. It is most necessary that those who seek to do equity between man and man should weigh facts uninfluenced by words hurled to prejudice. We can see no reason why this case cannot be determined on its facts.

This case appears to us to be very simple. There are only two questions before the court. We present claims 6-9 of the Wright patent in suit. Do these claims define a combination of parts that was non-existent prior to the Wright invention? Has defendant employed the combination *defined in claims 6-9?* The District Court answered both questions affirmatively. Appellant has presented page after page of involved and confusing argument, but appellant cannot show a device in the prior art containing the combination of

the claims in suit, nor a device that will perform the function thereof. A comparison of the claims with the infringing device establishes the finding of the trial court that the infringing device is "in every way the same as that claimed by the plaintiff in his last four claims." (R. p. 176).

Appellant contends that claims 6-9 in suit are not generic claims because in the drawings and specifications of his patent Wright described only one specific embodiment of his invention. The position of appellant is contrary to the well settled law. See Walker on Patents (5th Ed.), p. 134:

> "It is a proper practice to make a generic claim and also a specific claim, in an application for a patent on a generic invention, even where only one species is described in the specification."

Citing:

> Hill v. Hodge, 12 App. D. C. 530;
>
> J. L. Owens Co. v. Twin City Separator Co., 168 Fed. 259;
>
> Ryder v. Townsend, 188 Fed. 792;
>
> Zittlosen Mfg. Co. v. Boss, 219 Fed. 887.

> "He who invents one species before any other person invents either the genus itself or any of its species is entitled to a generic claim. It was not necessary for Ewart to refer, as he did in his original application, to the form of double socket shown above in Figure 2 in order to entitle him to a generic claim; for, while a reference to several species by way of illustration is admissible, *a de-*

scription of one species is as perfect a basis for a generic claim as a description of several."

Ex Parte Ewart, 17 O. G., 1189.

The foregoing rule is founded on R. S., Sec. 4888 providing that an inventor need only describe one embodiment of his invention in his patent. Having described one embodiment he has also thereby described the genus represented specifically by that embodiment. This follows from the fact that a species is necessarily a particular embodiment of its genus. We, therefore, find the rule that a description of a single specific embodiment is a proper basis for claims to the genus, as well as claims to the species.

> "A genus claim states in broad terms the essential characteristics common to all of a family or group, while a species claim is one of the many illustrations of the genus, and defines the peculiar characteristics that distinguish it from others of its kind."
>
> Rogers on Patents, Vol. 1, p. 58.

This apt definition finds perfect application in distinguishing between specific claims 1-5 and generic claims 6-9 of the Wright patent. The latter claims state "in broad terms the essential characteristics common" to the two specific embodiments of the Wright invention. One of these specific embodiments is found in the waffle iron *per se* as illustrated in plaintiff's Exhibit 3. The other specific embodiment constitutes plaintiff's exhibit 5 illustrated in the drawings of the patent in suit.

A comparison of claims 6-9 with both of these specific devices demonstrate that the claims read upon and recite the common elements and features found in both forms. For example claim 6 contains the following elements:

1. A pair of casings (pivotally connected together).
2. A waffle member (mounted in each casing).
3. An aluminum baking surface (for each waffle member).
4. A flange on each baking surface (covering the upper edge of its casing).
5. Means to electrically heat the waffle members.

There is positively no limitation in this claim warranting restricting it to "pivoting the casings together through a grill member" as appellant urges. Wright purposely specified broadly and generically that the casings should be "pivotally connected together." This certainly includes "directly" or "indirectly" because in either case the casings are pivotally connected together. All reference to the grill member was excluded. We submit that the claim is definite and clear and is not limited to the grill member.

As generic claims 6-9 are clear and unequivocal in terms they should be construed as written.

> "The court is not concerned with the motives which induced the patent officials to require or the patentee to accept the claim. It is enough that it is in the patent and that it is couched in language so plain and unambiguous as to leave no room for

construction. The courts must deal with claims not as they might have been but as they are."

Ryan v. Metropolitan, 144 Fed. 697; 75 C. C. A. 513.

Appellant further urges that the law of operation of the Wright invention as embodied in the specific composite iron and grill device is "repugnant" and "abhorrent" to that of the same invention as expressed in the waffle iron *per se*. This appears to us to be an attempt to cover by language that which is lacking in fact. In baking waffles the two specific devices function identically. The upper casing is first turned back and the waffle batter spread on the lower baking member. The upper casing is then folded down upon the lower casing. The heat is applied to the waffle baking members through identical electrical elements. The aluminum baking surfaces conduct the heat efficiently and directly to the batter. The flanges on the baking surfaces prevent the batter from adhering to the casings or from running down inside the casings. After the waffles are baked the upper casing is turned back and the pastry is removed. This is the way both specific forms of the Wright invention operate in baking waffles.

The waffles are baked in identically the same way and the devices function identically with both forms. The grill member does not enter into the waffle baking operation in the specific device illustrated in the patent drawings. Baking waffles and grilling meats are

independent and separate functions. The grill feature is excluded from claims 6-9 and is the subject of claims 1-5.

Appellant has adopted the specific form of the waffle iron *per se* and utilizes all of the benefits of that form. It is not necessary that appellant also employ the independent feature of the grill in order that infringement exist. As said by this court in its opinion rendered October 17, 1921, in Western Well Works v. Layne & Bowler:

> "It is not necessary, in order to maintain a suit upon such a patent, says the court, 'that there should be a violation of the patent throughout. It is sufficient if any one of the invented machines or improvements is wrongfully used; for that, *pro tanto,* violates the patent.'
>
> "To the same effect is Emerson v. Hogg, 2 Blatch. 1, 8; 8 Fed. Cas. 4,440, p. 613. Hogg v. Emerson, 6 How. 437; Hogg v. Emerson, 11 How. 587.
>
> "This rule applies to the invention described in a separate claim as well as to the invention described in the patent as a whole."

Necessarily there are specific differences between the two specific embodiments of the Wright invention. There necessarily must be such difference or there could not be more than one specific form. Claims 6-9 are not limited to any specific differences. To the contrary, claims 6-9 define generically only the features common to both forms. Claims 1-5 take care of the specific differences. The contention of appellant is

based on totally ignoring generic claims 6-9 and treating the patent as limited to the one form shown in the drawings. This position is contrary to law and is unjustified in view of generic claims 6-9 and in view of the fact that *Wright in fact produced both forms embodying his generic invention.*

Obviously to construe claims 6-9 to cover generically both specific embodiments of the Wright invention is not interpreting those claims to cover an inoperative device. Both specific forms admittedly perform their functions properly.

Appellant refers to the fact that the record contains no reply to the letter of December 9, 1915. This is a letter sent to an attorney in Washington, D. C. enclosing a sketch of the Wright waffle iron, plaintiff's exhibit 3, for the purpose of having a search made as to its patentability. (R. 215-217). The letter was offered in evidence while Mr. Wright was on the witness stand (R. 76). It was offered to prove that in fact Wright was the inventor of the specific form of his invention illustrated in plaintiff's exhibit 3 and that this device was completed prior to the filing of the application for the patent in suit. This testimony was not contradicted and there was no occasion or request that any reply to the letter should be produced. Counsel for appellant cross-examined Mr. Wright but did not ask for a reply to the search letter if there was a reply. Under these circumstances we submit that the unsupported romancing of counsel as to the possible contents of the pos-

sible reply is unjustified. It is customary to decide cases on proofs and not speculation.

Appellant urges that the court should limit the claims in suit to the specific form illustrated in the Wright patent drawings because of the statement appearing in the specification of the patent concerning the principal parts of the invention. It is elementary that the scope of a patent is set by the claims and that the specification is to be resorted to when necessary to determine what is referred to by the claims. Where the claims are clear they are to be interpreted as they stand. It is not the office of the specification to define the metes and bounds of the patent. Furthermore, the aforesaid statement in the Wright patent appears as part of the description of the specific form illustrated in the drawings. Undoubtedly, the statement refers to the principal parts of that specific form and has proper office as regards claims 1-5 of the Wright patent. As the inventor expressly excluded the grill member from claims 6-9, the statement must be restricted in application to specific claims 1-5. As the office of the claims is to set the metes and bounds of the monopoly and as claims 6-9 exclude the grill, the clear wording of those claims should not be overthrown by a statement in the specification intended to pertain to the species of claims 1-5. If there is any doubt it should be resolved in favor of the inventor. As to a similar statement see the decision of this court in Pederson v. Dundon, 220 Fed. 309.

Appellant represents that the specification of the Wright patent contains no statement indicating that it was not the intent of Wright to limit his patent to the specific form described. We believe this to be immaterial in view of the definite and clear character of claims 6-9. But in any event the representation is not founded in fact. At the close of his patent specification Wright stated that although he had described a certain particular form, he did not desire to be limited thereto in view of the "scope of my invention in its broadest aspect."

> "Although I have described my improvements with considerable detail and with respect to certain particular forms of my invention, I do not desire to be limited to such details since many changes and modifications may well be made without departing from the spirit and scope of my invention in its broadest aspect." (R. 213.)

Coupled with generic claim 6-9 definitely excluding the grill member we can see no room for doubt on this point. Compare the decision of this court in Kings County Raisin & Fruit Co. v. U. S. Consol. S. R. Co., 182 Fed. 59 at p. 64:

> "Not only is there nothing in the specifications or claims to indicate that Pettit intended to limit his claims to the precise form described, but the contrary is indicated by the terms of claim 18, and by the language of the specifications, in which it is said that:
>
> "'Various modifications may be made in the construction shown in the drawings and above

> particularly described, within the purview of my invention.' "

The entire position of appellant as to the character and scope of claims 6-9 in suit is not supported by law and is totally wanting in equity. Appellant refuses to recognize the unequivocal terms and meaning of claims 6-9 and endeavors to have the court treat the drawings and specifications of the Wright patent as the metes and bounds thereof. This contention violates the very nature of the patent grant. By statute the inventor describes and illustrates one specific form embodying his invention. He then gives notice of the scope of his patent by his claims. If appellant be correct *claims are useless* and no patent can cover anything except the one specific form illustrated in the drawings. That has never been sound law.

Wright was in fact the inventor of both specific forms in which his generic invention may be embodied. He had completed, tested and used, devices of both specific forms before filing his application for the patent in suit. In compliance with the statute and law he described one specific form in his drawings and specification and made claims 6-9 to cover both forms. Under the circumstances we submit that the court will protect that which Wright actually invented.

> "The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to

> the letter of the statute, or by the application of artificial rules of interpretation."
>
> Topliff v. Topliff, 145 U. S. 245.

We believe that the interpretation given by the District Court to claims 6-9 in suit is fully supported by the decisions of this court in Von Schmidt v. Bowers, and Los Angeles Art Organ Co. v. Aeolian Co. (cited at page 15 and 64 respectively of our opening brief). Particularly we ask the court to compare its reasoning appearing in the latter case in the bottom paragraph at 143 Fed. Rep., page 885. Appellant here urges that the grill member of claims 1-5 be interpolated into generic claims 6-9. In that case there was a similar attempt of appellant to "read into the claims such elements as are therein specified," referring to reading into generic claims elements appearing in the specification and other specific claims. This court there denied the contention of appellant.

Appellant is confronted with the fact that there exists no prior patent or device that contained the combination expressed in claims 6-9. In *extremis* appellant asks that we "set the table of the prior art." In this imaginary table appellant presents numerous prior devices and patents. Thereby appellant confesses in fact the lack of any anticipation in the prior art of claims 6-9. *To constitute an anticipation there must be present on that table* one device *that meets the claims in suit.* Scattering over the table a mass of devices, none of which meets the claims, is an admission

in law that no defense exists. If there is an anticipation why is it not presented alone on the table of the prior art? We cannot imagine a more graphic illustration of a defendant attempting to add and combine various features of prior devices to reinvent the patented combination. This court has oft repudiated such an asserted defense. (See citations at page 45 of our opening brief).

> "* * * it is no defense to a claim of an infringement that one or more elements of a patented combination, or one or more parts of a patented improvement, may be found in one old patent or publication, and others in another, and still others in a third. It is indispensable that all of them, or their mechanical equivalents, be found in the same description or machine, where they do the same work by substantially the same means." (Citing numerous authorities.)
>
> J. L. Owens v. Twin City Separator Co., 168 Fed. 259 at 265, C. C. A. 8th Cir.

Appellant asserts that the Crompton patent (R. 169-171) discloses the "dominant idea" of the Wright invention. If this is intended to mean that the Crompton patent discloses the combination of claims 6-9 in suit then we deny absolutely the assertion. First let us examine the language and drawings of the Crompton patent.

The Crompton patent was issued by the British patent office and pursuant to the practice in that office contains a "provisional specification" and a "complete specification." The "provisional specification"

was filed May 19, 1893, and the "complete specification" was filed February, 1894. (R. 169). In judging the terms of the Crompton patent it should be borne in mind that these two specifications are separate and distinct and that the latter supersedes the former. That portion of the "complete specification" preceding the reference to the figures of the drawing is a duplication of the "provisional specification."

The Crompton patent recites first that "unsatisfactory results are obtained" with "plain flat electrically heated surfaces." "In order to meet this difficulty" Crompton proposes to "roughen these surfaces." He then states that in some cases, we prefer "to use two directly heated surfaces both of which may be formed as above," etc. By "formed as above" the patent clearly refers to making the surfaces rough in lieu of plain flat. This necessarily follows from the presence of the term "above." The sole antecedent for the term "above" is the matter of roughening the cooking surfaces. Clearly this clause is not a direction for mounting two surfaces in box-like casings. A reference to mounting the bottom surface in a casing appears for the first time several paragraphs later in the Crompton patent under reference to figure 1 of the drawings. This structure is therefore referred to "below" and not "above" the aforesaid clause.

In fact the sole description in the Crompton patent of the structure of the "lid" is with reference to the "lid a^x" which is illustrated in figure 3 of the drawings and does not constitute a box-like casing, etc.

We are much surprised at the misleading reference by appellant to figures 4 and 5 of the Crompton drawings. Figure 4 is stated to be "a portion of the *upper surface* of such a heating appliance." This clearly refers to the roughened surface in the lower casing, and not at all to an upper casing. This is established by figure 5 which is stated to be "a side view of figure 4." An examination of figure 5 discloses the roughened surface upon the lower casing. The casing is broken away and is definitely illustrated as being *below* and containing the roughened surface. This is not a view of the "lid" because the "lid" would be upside down with the roughened surface below the casing, if there was one.

We are satisfied that the Crompton patent does not disclose a pair of "pivoted casings" as defined in the Wright patent. We again call to the attention of the court that this is a foreign patent and is to be given effect only as to what is clearly shown. (See authorities cited at page 34 of our opening brief).

In fact Crompton had no conception of a waffle iron whatever. His device could not be used for baking waffles. *It contains no waffle baking members.* The hinges of the Crompton patent render it impossible to bake waffles thereon. Wright was the first to conceive of an electrically heated waffle iron having the elements and features defined in claims 6-9 of his patent. The following elements of the claims in suit are not present in the Crompton device:

1. Waffle baking members.
2. Aluminum cooking surfaces and flanges.
3. An upper casing pivoted to the lower.

Appellant urges that the provision of aluminum surfaces and flanges by Wright does not lend patentability. In fact, Wright was the first to combine an electric heating element and an aluminum cooking surface and encase the same in thin pressed steel casings. Thereby the heat is directed to the waffle batter efficiently and properly due to the conductivity of aluminum. (R. 99). This combination permits the device to be employed on an ordinary house socket, which has a low current as a matter of common knowledge. This combination did not exist in the prior simplex iron. If the baking surface and casing all be cast in one of aluminum it is obvious that the heat will be dissipated throughout the casing. The novel use of aluminum in this combination is patentable.

Walker on Patents, 5th Ed., p. 32.

George Frost Co. v. Samstag, 180 Fed. 739 (C. C. A. 2nd Cir.).

George Frost Co. v. Cohn, 119 Fed. 505 (C. C. A. 2nd Cir.).

Appellant is forced to admit that the Crompton device requires "modifying it in detail" to enable it to perform the function and meet the claims of the Wright invention and patent. Under the established law then the Crompton patent is not an anticipation, because it would require knowledge of the Wright invention to

perceive the necessity or occasion for making the modification. It is elementary that the Wright patent may not be invalidated merely because these modifications appear simple after seeing the Wright invention. In Hobbs v. Beach, 180 U. S. 383, 451 Ed. 586, it was urged that the only modification required to enable a prior device to constitute an anticipation was a simple substitution that any mechanic could make after knowledge of the patented invention. The Supreme Court held that this was no defense and said:

> "* * * the invention consisting rather in the idea that such change could be made than in making the necessary mechanical alterations."

The Supreme Court also used the following language analogous to the ancient grant of the Crompton patent:

> "It appears from the testimony that several of these addressing machines, of which that of Dennis and York is a type, and which are now claimed to have inspired the Beach patent, had been upon the market for many years, and yet it never seems to have occurred to anyone engaged in the manufacture of paper boxes that they could be made available for the purpose of attaching strips to the corners of such boxes. This very fact is evidence that the man who discovered the possibility of their adaptation to this new use was gifted with the prescience of an inventor."

We are surprised to note the denial of appellant that the twenty-two years intervening between the grant of the Crompton period and the Wright invention is

not evidence that it was not an obvious matter to make the necessary modifications in the Crompton patent. The case of Brill v. Washington R. & E. Co. referred to by appellant is a case where the prior patent disclosed the precise patented invention. Therefore, the date of the prior patent was immaterial. That case does not controvert the common sense doctrine that a long period of time intervening between the issuance of a prior patent and the patent in suit indicates that the valuable modifications incorporated in the later patent were not obvious in the prior patent. This is established by the last quotation from Hobbs v. Beach (*supra*). In the opinion of the Supreme Court rendered by Chief Justice Taft on November 7, 1921, in the case of Hildreth v. Mastoras, the court refers to such a delay as demonstrating the *"long delayed and therefore not obvious step."*

The assertion of appellant that it followed the teachings of the Crompton patent is not supported in fact or by the record. Counsel for appellant filed an affidavit in the District Court that appellant never heard of the Crompton patent until after the trial of this case. (R. 164-168).

We believe it clear that the Crompton patent is a familiar example of a defendant in a desperate attempt to invalidate the patent in suit, offering a device long hidden in the art, which device bears mere superficial resemblance to the patented invention in suit. It being the nearest prior art it is much praised and defendant urges that it

might be modified to create an anticipation. This is not a defense. The Crompton patent does not disclose the patented combination. In fairness to appellee we respectfully ask the judges of this court if any of them would purchase a Crompton device to serve the purpose of the Wright waffle iron?

We note the assertions made by appellant concerning the Simplex iron and deem them fully met by our opening brief. (pp. 41-42). Counsel for appellant base their argument on questioning the uncontradicted testimony of their own expert and vice-president of appellant, Mr. Lamb, who admits that the Simplex device is more expensive to make and will not operate on a house current. (R. 65). The Simplex iron lacks the leading and essential elements and features of the Wright invention defined in claims 6-9 in suit.

Much of appellant's argument is based on the fact that Wright has not commercially exploited his invention. We have heretofore pointed out that this is due to defendant's pirating the market and that this suit was filed within fourteen months after the grant of the Wright patent. (Appellee's Opening Brief, pp. 71-73). But commercial exploitation is totally immaterial. In the recent case of Hildreth v. Mastoras (*supra*), Chief Justice Taft says:

> "It is not necessary, in order to sustain a generic patent, to show that the device is a commercial success."

In conclusion we beg to state that the entire argument of appellant is based on the fallacious premise

that the only thing Mr. Wright invented was the specific composite iron and grill device illustrated in the drawings of the patent in suit. In fact the record establishes by uncontradicted documentary evidence that Mr. Wright also invented and placed in practical use his specific waffle iron of plaintiff's exhibit 3 prior to filing application for the patent in suit. Under the law Mr. Wright described one specific form of his invention and gave proper notice to the world by generic claims 6-9 that he desired to cover generically any and all forms. Generic claims 6-9 were granted by the patent office and define a combination that did not exist in the prior art. This combination has been appropriated by defendant.

We submit that the decree of the District Court should be affirmed.

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